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OFFICE OF PETITIONS

In re Application of	:
Steven E. Koenck	:
Application No. 10/040,256	: DECISION ON PETITION
Filed: December 31, 2001	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 38219 RA	:

This is a decision on the petition under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6), filed July 15, 2002, to accept an unintentionally delayed claim for the benefit of priority to the prior-filed nonprovisional and provisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2) and 1.78(a)(5). In addition, the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR 1.78(a)(2) and 1.78(a)(5) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and 1.78(a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

Petitioner seeks, by way of the instant petition, to amend the specification by inclusion of a reference to prior-filed nonprovisional Application No. 09/068,685, filed

May 13, 1998, which was the National Stage of International Application No. PCT/US96/17916, filed November 15, 1996, which claimed the benefit of U.S. Provisional Application No. 60/006,755, filed November 15, 1995.

It is noted that the declaration filed with the instant application referenced PCT/US96/17916 and provisional Application No. 60/066,755 (which should be "60/006,755"). Additionally, the transmittal letter submitted with the application included a reference to prior-filed nonprovisional Application No. 09/068,685. The Office noted the claim for priority of nonprovisional Application No. 09/068,685 and of provisional Application No. 60/066,755, the wrong application number as noted above, but not the claim for priority to the PCT application.

The instant pending application was filed on December 31, 2001, and was pending at the time of filing of the instant petition. Further, copendency exists between the instant application and between each of the prior-filed nonprovisional and provisional applications noted in the amendment, for which a claim for benefit of priority is now being sought. A reference to the prior-filed nonprovisional and provisional applications has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(3) and 1.78(a)(6).

While a reference to prior-filed nonprovisional Application No. 09/068,685 was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter for the instant application.

The current procedure where a claim for priority under 37 CFR 1.78(a)(3) and 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application will be scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR 1.78(a)(2) and 1.78(a)(5). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed applications in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(3) and 1.78(a)(6).¹ In the instant case, the Office noted the claim for priority to nonprovisional Application No. 09/068,685 in the transmittal letter, as shown by its inclusion on the filing receipt.

¹ Note 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

However, a petition is necessary in the instant application because a claim for the benefit of priority to the National Stage of International Application No. PCT/US96/17916 and the correct provisional application, namely, Application No. 60/006,755, was not included in the manner specified in 37 CFR 1.78(a)(2) and 1.78(a)(5).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed national stage PCT application and the provisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2) and 1.78(a)(5). Also, the reference to the prior-filed applications was submitted during the pendency of the instant nonprovisional application. See 35 U.S.C. §§ 120 and 119(e). Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120 and 119(e) to the prior-filed applications satisfies the conditions of 37 CFR 1.78(a)(3) and 1.78(a)(6), the petition is granted as of the date of filing the petition.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to the Office of Initial Patent Examination Division for pre-examination processing and for mailing out a corrected Filing Receipt which includes a reference to the prior-filed applications and the projected publication date of the instant application.



Frances Hicks

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for Patent Examination Policy